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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,736	11/13/2003	Indran Naick	AUS920030776US1(4015)	2704

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EXAMINER

JEAN GILLES, JUDE

ART UNIT

PAPER NUMBER

2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/713,736	Applicant(s) NAICK, INDRAN	
	Examiner Jude J. Jean-Gilles	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to communication filed on 11/13/2003.

Information Disclosure Statement

1. The references listed on the Information Disclosure Statement submitted on 11/13/2003 have been considered by the examiner (see attached PTO-1449A).

Claim Objections

2. Claim 20, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. In claim 20, "the method according to claim 22" is interpreted as being "the method according to claim 19". Examiner assumes this is a typographical error and appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. **Claims 1-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Godfrey et al (Godfrey), Patent No. 6,941,349 B2.

Regarding **claim 1-20**, Godfrey discloses:

1. A method for selectively transmitting an email attachment, the method comprising:

receiving an instruction from a sender to add a selectable notification of an email attachment to a first email (figs. 12, and 13; column 5, lines 33-59; note that accepting and declining the meeting request inherently comprises the step of selecting the notification);

inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient (column 5, lines 32-67);

generating a second email having the email attachment upon receipt of the reply; and transmitting the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).

2. The method of claim 1, further comprising prompting the recipient prior to transmission of the reply to the sender (column 19, lines 33-42).

3. The method of claim 2, wherein prompting the recipient comprises requesting the recipient add comments for the sender to the reply (column 19, lines 33-42).

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4. The method of claim 1, further comprising prompting the sender prior to transmission of the second email to the recipient (column 5, lines 45-60; repeat steps 1 through 8).

5. The method of claim 4, wherein prompting the sender comprises requesting the sender to locate the email attachment to transmit the second email to the recipient (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

6. The method of claim 4, wherein prompting the sender comprises requesting the sender add comments for the recipient to the second email (column 5, lines 45-67).

7. The method of claim 1, wherein receiving the instruction comprises receiving the instruction to exclude the email attachment from the first email (column 19, lines 24-52);

8. The method of claim 1, wherein inserting code in the first email comprises inserting a markup language (figs. 12, and 13).

9. The method of claim 1, wherein inserting code in the first email comprises inserting an icon and linking the code to the icon (figs. 12, and 13).

10. A device for selective transmission of an e-mail attachment by a recipient, the device comprising: a notification incorporator to add a selectable notification of an email attachment to a first email in response to an instruction from a sender (figs. 12, and 13;

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column 5, lines 33-59); a code associator to insert code in the first email to transmit a reply to the sender upon execution of the code by an email client and to associate execution of the code with activation of the selectable notification by the recipient (column 5, lines 32-67); and an attachment responder to generate a second email having the email attachment upon receipt of the reply and to transmit the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).

11. The device of claim 10, wherein the code associator inserts code comprising at least one prompter, wherein the at least one prompter permits optional entry of text in the reply (figs. 12, and 13).

12. The device of claim 10, wherein the attachment responder comprises at least one prompter, wherein the prompter permits optional entry of text in the second email (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

13. The device of claim 10, wherein the attachment responder comprises at least one prompter, wherein the prompter requests the sender to locate the email attachment (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

14. The device of claim 10, wherein the notification incorporator is responsive to the

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instruction, wherein the instruction excludes the email attachment from the first email (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

15. The device of claim 10, wherein the code associator inserts code comprising a markup language (figs. 12, and 13).

16. The device of claim 10, wherein the code associator inserts an icon and associates the icon with the code (figs. 12, and 13).

17. A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment, comprising: receiving an instruction from a sender to add a selectable notification of an email attachment to a first email (figs. 12, and 13; column 5, lines 33-59); inserting code in the first email to transmit a reply to the sender upon execution of the code by an email client, wherein execution is responsive to activation of the selectable notification by a recipient (column 5, lines 32-67); generating a second email having the email attachment upon receipt of the reply; and transmitting the second email to the recipient in response to the reply (column 5, lines 45-60; note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment).

18. The machine-accessible medium of claim 17, wherein the operations further

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comprise instructions for prompting the recipient prior to transmission of the reply to the sender (figs. 12, and 13; column 5, lines 45-60; repeat steps 1 through 8).

19. The machine-accessible medium of claim 17, wherein the operations further comprise instructions for prompting the sender prior to transmission of the second email to the recipient (figs. 12, and 13; column 5, lines 45-60).

20. The machine-accessible medium of claim 20, wherein prompting the sender comprises requesting the sender to locate the email attachment to transmit the second email to the recipient (column 5, lines 45-67; *note that step 1 through 8 can be repeated to create the second reply from the sender with the email attachment*).

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Conclusion

5. **THIS ACTION IS MADE NON-FINAL.** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

March 11, 2007


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100